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IN THE

Supreme Court of the United States

October Term, 1977.

No. 78-250

EUGENE A. WAHL and VIBRA SCREW, INCORPORATED,
Petitioners,

v.

SOLIDS FLOW CONTROL CORPORATION,
Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Third Circuit.

RESPONDENT'S BRIEF IN OPPOSITION.

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ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT.

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QUESTIONS PRESENTED FOR REVIEW.

(1) Did the Third Circuit Court of Appeals properly apply the rule established by this court in *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation*, 402 U. S. 313 (1971) of estoppel against proceeding with a second suit under a patent which had been held invalid following full and fair trial in a forum of petitioners' choosing?

(2) Is the *Blonder-Tongue* rule subject to an exception, asserted by petitioners, as they had argued the wrong theory of operation of the patent in suit in the Seventh and Sixth Circuits?

STATEMENT OF THE CASE.

Petitioners' petition is from the Third Circuit Court of Appeals' affirmance of the trial Court's granting of respondent's summary judgment motion based on petitioners' estoppel, under *Blonder-Tongue* (*Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation et al.*, 402 U. S. 313, 334), from relitigating in the Third Circuit, the patent in suit, 3,173,583 ('583), which had been previously ruled invalid in the Seventh and Sixth Circuits.

The ruling of the Third Circuit Court of Appeals is embodied in the transcript of the argument (printed at A4-A19 of petitioners' appendix). The judgment of the United States Court of Appeals for the Third Circuit was entered April 12, 1978; rehearing was denied on May 15, 1978.

PETITIONERS' PRIOR LITIGATION UNDER THE PATENT IN SUIT.

Petitioners' first litigation under the patent in suit '583 was in the District Court for the Southern District of Indiana (*Wahl et al. v. Carrier Mfg. Co.*, 1969) wherein, after a full trial on the merits, the patent was ruled invalid in view of petitioners' sale of the Heavy Duty feeders over a year prior to the filing date of application for the patent in suit (a statutory bar, 35 U. S. C. § 102).

In Finding of Fact No. 10(d) the Indiana Court ruled: "(d) The Court finds that the claims of the patent in suit may be read on the structure of the heavy duty feeder, and that none of the prior art cited by the Patent Office is as pertinent to the invention claimed in the Wahl patent as the Wahl heavy duty feeder. If the Patent Office, during the prosecution of the application for the Wahl patent, had before it the drawing of the heavy duty feeder (Exhibit B), with the knowledge that the device was on sale in 1959, the Patent Office would not, in the opinion of the Court, have granted any claims in the Wahl application (R. 876-877)." (19a, Court of Appeals Appendix).

The Indiana Court, in Conclusion of Law No. 2, ruled: "The claims of the patent in suit are invalid because anticipated by the heavy duty feeder sold by Vibra Screw more than one year prior to the filing of the original application for the patent in suit." (29a, Court of Appeals Appendix).

Any alleged new theory of operation (*infra*) if, as, and when provable, and if, as, and when proper under *Blonder-Tongue*, cannot erase the estoppel finality of the first (Indiana) case in view of the Court's finding (never reversed) of invalidity of the patent in suit in view of petitioners' one year prior use (35 U. S. C. § 102) therein established.

The patent in suit was further held invalid by the Indiana Court for obviousness (35 U. S. C. Sec. 103):

> "3. The Claims of the Wahl patent are anticipated by the disclosure of Carrier patent No. 3,187,884 and by the Vibra-Portioner sold by defendant prior to any date of invention asserted by Wahl in this case.
>
> "4. The claims of the patent in suit are anticipated by Muschoot patent No. 3,083,811.
>
> "5. Alternatively, and in addition to the anticipation referred to above, on the question of obviousness, under Title 35 U. S. C. Sec. 103, the Conclusion of Law is reached that the differences between the subject matter sought to be patented in the Wahl patent and the prior art referenced to above are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains." (30a, appendix Court of Appeals).

The Indiana District Court was affirmed in a comprehensive unanimous opinion; *Wahl v. Carrier Mfg. Co., Inc.* 452 F. 2d 96 (7th Cir. 1971) c. d. 405 U. S. 990 (1972).

Petitioners, having thus lost at each level in the Seventh Circuit, relitigated the patent in the Sixth Circuit, *Wahl et al. v. Vibranetics, Inc.* 176 USPQ 234 (W. D. Kentucky, 1972). The defendant therein moved for summary judgment, submitting, as part of its moving papers, the entire thirteen hundred page transcript of the Indiana action, and a certified copy of the six hundred page appendix on the appeal to the Seventh Circuit Court of Appeals.

After reviewing the record of the Indiana case and concluding that the Indiana trial Judge had fully grasped the technical matters involved, the trial Court (Kentucky) entered summary judgment for defendant; the Sixth Circuit affirmed; *Wahl v. Vibranetics, Inc.*, 474 F. 2d 971 (6th Cir. 1973) c. d. 414 U. S. 859 (1973).

* * *

Plaintiffs are thus pursuing herein precisely the sort of super-saturation of patent litigation which prompted this Court, in *Blonder-Tongue*, to reverse the theretofore previously countenanced (under *Triplett v. Lowell*, 297 U. S. 638), permissiveness re suits under patents previously held invalid.

This Court, (at 334 of *Blonder-Tongue*) repudiated the *Triplett* doctrine, saying: "We are not persuaded, therefore, that the Triplett rule, as it was formulated, is essential to effectuate the purposes of the patent system or is an indispensable or even an effective safeguard against faulty trials and judgments."

PETITIONERS' ALLEGED NEW THEORY.

Petitioners allege that they have a new theory of operation of the patent in suit, which petitioners' attorney thus explained to the Third Circuit Court on the argument of the appeal thereto (petitioners' appendix A-10): "A JUDGE: As I understand Mr. Ferrill's proposition, he doesn't urge a new principle, but he [12] urges that there is a new understanding of the old principle. MR. FERRILL: That is exactly right, Your Honor."

In petitioner Wahl's affidavit (Appendix to Briefs, Court of Appeals, 76-78a) he says (paragraph 10) that "At the trial in Indiana there was not a clear, consistent theory presented other than the over-generalized and inaccurate theory that the provision of a vibrating plate (within a material receiving housing which is itself vibrated)" (etc.) and in the next sentence, says what he now envisions: "As I now envision the operation of the bin activator" (etc.) and refers to appendices A-C. In the next paragraph (No. 11) he admits he cannot prove his new visionary theory: "Even though I cannot prove, mathematically or otherwise, that the significant internal contributory effects to flow promotion are exactly as described in Appendices D through F hereto, these represent actions which I believe to be occurring" (etc.).

Petitioners' above recited protestations are repudiated in *Moore's Federal Practice* (Second Edition) ¶¶ 59.08[3] pp. 59-115—59-117: "A party who has failed to evaluate evidence properly and thereby failed to submit it at the trial, or a party who desires to present his case under a different theory in which facts available at the original trial now first become important, will not be granted a new trial."

CONCLUSION.

It is respectfully submitted that the petition for certiorari should be denied, for the reasons and under the authorities above set forth.

Respectfully submitted,

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